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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/575,902	04/14/2006	Ekkehard Roth	P29527	4685
7055 7590 01/23/2009 GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191				
EXAMINER HUDA, SAIED M				
ART UNIT		PAPER NUMBER		
1791				
NOTIFICATION DATE		DELIVERY MODE		
01/23/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/575,902

Applicant(s)

ROTH, EKKEHARD

Examiner

SAEED M. HUDA

Art Unit

1791

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08/01/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date 08/01/2006
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101 & 35 USC § 112

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-9 and 11-12 provide for the method for producing a fiber-composite material for producing fiber-composite components, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.
3. Claims 1-9 and 11-12 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).
4. Claims 5-7 and 11-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites the limitation "the resin filler mixture". There is insufficient antecedent basis for this limitation in the claim.

Objections

5. The first sentence of the abstract is objected to for having cumbersome phrasing. Correction is required.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skinner et al. (US 2004/0130067 A1).

Skinner et al. disclose a method of molding a high density composite article which is composed of fiber reinforcement, resinous material, and fillers (abstract and [0005]) that can be particulate (ground) or chopped strands ([0019]) where the resinous material is loaded with a filler ([0005]). Skinner et al. teach the average particle size of the filler is sufficiently small whereby only the resinous material and small particulate fillers penetrate said reinforcing material layer ([0019]). Skinner et al. fail to explicitly disclose the filler size; however, absent evidence of unexpected results obtained from using a filler of the claimed size, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have selected a suitable filler size to

effectively strengthen the composite, the filler size being a result effective variable routinely optimized by those of skill in the art. The optimization of a range or other variable within the claims that flows from the "normal desire of scientists or artisans to improve upon what is already generally known" is prima facie obvious. *In re Peterson*, 315 F.3d 1325, 1330 (Fed. Cir. 2003) (determining where in a disclosed set of percentage ranges the optimum combination of percentages lies is prima facie obvious). The discovery of an optimum value of a variable in a known process is usually obvious. *In re Aller*, 220 F.2d 454, 456 (C.C.P.A. 1955). See also *In re Boesch*, 617 F.2d 272, 276 (C.C.P.A. 1980) ("[D]iscovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art."). See also *In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997) ("[I]t is not inventive to discover the optimum or workable ranges by routine experimentation." (quoting *Aller*, 220 F.2d at 456)); *In re Kulling*, 897 F.2d 1147, 1149 (Fed. Cir. 1990) (finding no clear error in Board of Patent Appeals and Interferences' conclusion that the amount of eluent to be used in a washing sequence was a matter of routine optimization known in the pertinent prior art and therefore obvious).

8. Claims 5-6 and 11-12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Skinner et al. (US 2004/0130067 A1) as applied to claim 4 above, and further in view of Taylor et al. (US 6461457 B1).

Taylor et al. teach a method for producing a stretch-thinned elastic article (abstract) where a stretch-thinned film article (preform) is made and is formed of thermoplastic block copolymer loaded with a filler (9column 2, lines 21-29). The stretch-

thinned articles produced in accordance with the method of this invention may be bonded to facing materials including wovens, nonwovens, knits, nets, foam-like materials, paper, and tissue, thereby forming a laminate structure (column 8, lines 49-55). It would have been obvious to one skilled in the art at the time of the invention to use the film forming process of Taylor et al. in the invention of Skinner et al. because the film is dimensionally stable overtime and at elevated temperatures (column 2, lines 1-3), so shrinkage will not be an issue.

9. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Skinner et al. (US 2004/0130067 A1) as applied to claim 1 above, and further in view of Muser et al. (US 4556529).

The modified invention of Skinner et al. fails to teach the use of mold to process layered components. Muser et al. teach a method for bonding molded components to film, sheeting or shaped members, in which the molded element is constituted of plastic resin and filler, and is bonded to the sheeting or member. Muser et al. go on to teach that the sheeting or film is introduced into a mold and processed (abstract). In the creation of a product that has resin filler film "skins", it would necessarily follow that the resin filler film would need to be introduced into the mold prior to the textile product. It would have been obvious to one skilled in the art at the time of the invention to use the mold and layered molding method to process the modified invention of Skinner et al. because such is an art recognized method of forming layered products as exemplified by the teaching of Muser et al.

10. Claim 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skinner et al. (US 2004/0130067 A1) as applied to claim 1 above, and further in view of Minami et al. (US 3962009).

Minami et al. teach a method to apply a coat layer onto a composite materials where a resin composition mixed with a filler is spray coated onto the composite. The semi-finished product can be used to produce preforms (column 11, lines 26-32). It would have been obvious to one skilled in the art at the time of the invention to use a spray method in the invention of Skinner et al. because spray molding is a known resin application method as exemplified by the teaching of Minami et al.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SAEED M. HUDA whose telephone number is (571)270-5514. The examiner can normally be reached on 8:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Steven P. Griffin/
Supervisory Patent Examiner, Art
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/SAEED M. HUDA/
Examiner, Art Unit 1791